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REMARKS

Applicant appreciates the attention of the Examiner to the application. The Office Action of the Examiner of February 10, 2004 has been reviewed with care in the preparation of this response. The amendment above and the following remarks are believed to be fully responsive to this action.

Status of Claims

Claims 1-20, 27-45, as presented by the above amendment, are pending. The pending claims set forth a novel and non-obvious spinnerbait fishing lure. Reconsideration and allowance of all pending claims is respectfully requested in view of the above amendment and the following remarks.

Applicant thanks the Examiner for the telephonic interview with counsel on April 12, 2004, and both the Examiner and Supervisory Patent Examiner Peter Poon for the telephonic interview on May 4, 2004. In response to the discussion had during these interviews regarding proposed amendments to certain of the pending claims and in particular to claim 1, the Examiner indicated that the proposed claims did overcome the rejections set forth in the Office Action under 35 U.S.C. §112 and made a suggestion for the further amending of claim 1 for it to be allowable over the prior art. Following the suggestion of the Examiner and the Supervisory Patent Examiner, Applicant has prepared this Response. Applicant believes that the Response, with both the above amendment and the following remarks and argument, traverses all rejections in the Office Action and places the application in condition for allowance.

Claims 1-33 were rejected by the Examiner in the Office Action. Claims 1-4 and 33 were rejected as being anticipated under 35 U.S.C. §102(b) by Ogle (U.S. Patent No. 5,253,446). Claims 1-4, 27-30, and 33 were rejected as being anticipated under 35 U.S.C. §102(e) by Link (U.S. Patent No. 6,601,336). Claims 5-9 and 13 were rejected as being unpatentable under 35 U.S.C. §103(a) over Ogle or Link as applied to claim 4 and further in view of Smith (U.S. Patent No. 4,640,040). Claims 10-12, 18-20 and 25-26 were rejected as being unpatentable under 35 U.S.C. §103(a) over Ogle, Link, Ogle as modified by Smith, Link as modified by Smith, Ogle as modified by Link, or Link as modified by Link, as applied to claims 2, 5, 17 and 24 and further in

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view of Link. Claims 14-17 were rejected as being unpatentable under 35 U.S.C. §103(a) over Ogle or Link as applied to claim 2 and further in view of Link. Claims 21 and 23-24 were rejected as being unpatentable under 35 U.S.C. §103(a) over Ogle or Link as applied to claim 2. Claim 22 was rejected as being unpatentable under 35 U.S.C. §103(a) over Ogle or Link as applied to claim 21 and further in view of Link. Claims 27-32 were rejected as being unpatentable under 35 U.S.C. §103(a) over Ogle as applied to claim 2 and further in view of Link. Claims 31-32 were rejected as being unpatentable under 35 U.S.C. §103(a) over Link as applied to claim 30 and further in view of Link. Claims 2, 7, 15, 27 and all claims that depend from those claims were rejected as indefinite under 35 U.S.C. §112 ¶2.

Claims 1-3, 6-7, 10, 17-18, 20, 27-29, and 32 have been amended. Claims 21-26 have been canceled. The amendment adds new claims 34-45. The proposed amendment is fully supported by the specification to the application and does not include any new matter. The new claims are not disclosed or described by the references cited in the Office Action but are instead patentably distinguishable over such prior art.

Applicant now turns to particular points raised by the Examiner in the Office Action of February 10, 2004.

Rejection of Claim 1 under 35 U.S.C. §102(b)

Claim 1 was rejected under 35 U.S.C. §102(b) as anticipated by Ogle and Link. Claims 2-20 and 33 are dependent to claim 1. Anticipation requires that the identical invention to that contained in a claim be described in a single prior art reference. Richardson v. Suzuki Motor Co., 868 F.2d 1226, 9 USPO 2d 1913 (Fed. Cir. 1989). Claim 1, as amended, is directed to an improved spinnerbait lure having several structural features that are not disclosed by either Ogle or Link.

Applicant's claimed lure includes a jig having a jig-head and a hook that is embedded within the frame of the lure. This feature is missing in Ogle since that reference only discloses a hook having an eyelet that is guided over an arm of the lure. Since the arm is formed from wire, the hook is held in place by simply bending the free end of the wire to create a loop. The loop is

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then kept closed with solder. (Ogle at column 3, lines 41-46) No part of the hook in Ogle is embedded within the arm or any other portion of the lure.

The frame in amended claim 1 is formed from an integral length of polymeric material. The lure in Ogle is comprised of a ring 12 and two extension arms 16, 19. The preferred embodiment is directed to a lure that has the loop and arms formed from a single piece of wire. An alternative embodiment is disclosed having polymeric material but only one where such material is used to make the elliptical ring 12. (Ogle at column 4, lines 20-27) There is no disclosure in Ogle of the arms being formed from plastic much less the entire frame, i.e., ring and extension arms, being made from a single piece of polymeric material.

In addition, Applicant's frame in amended claim 1 has upper and lower arms extending divergently from a frame-vertex. This is an additional feature not disclosed in Ogle since the two extension arms 16, 19 diverge from tapered tip 14 where solder is applied to secure the ring 12 to itself. This point of divergence is not the frame-vertex since the apparent frame-vertex (a feature proximate to 20a in FIG. 1 of Ogle) is on the opposite side of the ring from the tapered tip.

A jig having a jig-head and a hook that is embedded within the frame of the lure is also missing from Link. The frame stated by the Examiner to be disclosed in Link is a structure comprising an elastomer collar 20 and elastomer filaments 22. This assembly is attached to a jig 2 by mounting the collar 20 around an appendage 16 projecting from the jig-head 4. There is no disclosure of any embodiment of the lure in Link where the jig is embedded within the elastomer frame.

Link furthermore is missing the feature in amended claim 1 directed to a frame having a predetermined shape in a non-stressed condition, the shape having the frame's upper and lower arms in a substantially fixed configuration with one another, where the frame is formed from polymeric material selected such that the frame always retains the original configuration absent force-induced flexing sufficient to break the frame. Link discloses a structure made from elastomer material where the filaments return to a flaccid configuration when force-induced flexing is withdrawn. The suggested frame structure in Link has no predetermined shape to which it returns whenever in a non-stressed condition. When stress is removed from the elastomer

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assembly in Link, the configuration of the filaments with respect to one another will continuously vary over time.

Absent these structural features, the lure described in amended claim 1 is not anticipated by Ogle or Link. "A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." Verdegaal Bros. v. Union Oil Co. of California, 814 F.2d 628, 631, 2 USPQ 2d 1051, 1053 (Fed. Cir. 1987).

Applicant respectfully traverses the rejection under 35 U.S.C. §102(b) of independent claim 1 and requests that the rejection of claim 1, as well of claims 2-20 and 33 that depend from it, be withdrawn.

Rejection of Claim 2 under 35 U.S.C. §102(b)

Claim 2, as amended, further claims that the lure's frame is dimensioned to exhibit durability and vibratory action during fishing. There is no disclosure of such a limitation in either Ogle or Link. Ogle has only a description of an embodiment where the lure's ring is formed from plastic molded over a metal reinforcing form to give it stability. (Ogle at column 4, lines 23-25) Nothing is stated or shown directed to the durability or vibratory action of the ring with use. Likewise, although some degree of oscillation may be inherent with an elastomer projection, Link fails to disclose or describe a frame structure that exhibits both vibratory action and the durability that allows the frame to resist fraying and abrasions. For these reasons, Applicant asks that the specific rejection of claim 2, and of claims 3-20 that are dependent from it, be withdrawn.

Rejection of Claims 5, 6 and 7 under 35 U.S.C. §103(a)

Claims 5-7 were specifically rejected under 35 U.S.C. §103(a) as being unpatentable over Ogle or Link in view of Smith. Obviousness under 35 U.S.C. §103(a) can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. In re Jones, 958 F.2d 347 (Fed. Cir. 1992). In addition, any such combination or modification of the prior art must still teach or suggest each and every one of the claim limitations. MPEP §2143. None of

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the references cited by the Examiner, however, teach or suggest all of the limitations set forth in claims 5-7.

In particular, there is no teaching or suggestion offered in any of the references directed to a frame having upper and lower arms extending divergently from a frame-vertex where the upper arm has an oblong cross-section, a feature identified in claim 5 and thereby in each of the claims that depend from it. The Examiner acknowledges that Ogle and Link fail to disclose such a limitation. Although the Examiner states that such an upper arm is taught by Smith, the structure in question is identified as being the one having reference number 12. This feature is described in Smith, however, as being a rear track portion of a cyclic fishing lure. The Smith lure therefore has neither upper or lower arms extending from a frame-vertex.

Even if arguably Smith does disclose an upper arm having an oblong cross-section, there still must be more of a justification for combining the references cited than solely the fact that a particular combination of structural features happened to have been known at the time of the invention. An examiner may not select from the prior art the separate components of the claimed invention by simply using the blueprint supplied by the inventor. Interconnect Planning Corp. v. Feil, 774 F.2d 1132, 227 USPQ 543 (Fed. Cir. 1985). "To prevent the use of hindsight based on the invention to defeat patentability of the invention, this court requires the examiner to show a motivation to combine the references that create the case of obviousness. In other words, the examiner must show reasons that the skilled artisan, confronted with the same problems as the inventor and with no knowledge of the claimed invention, would select the elements from the cited prior art references for combination in the manner claimed." In re Rouffet, 149 F. 3d 1350 at 1357-1358; 47 USPQ 2d 1453 (Fed. Cir. 1998).

In the Office Action, there is no showing by the Examiner of any motivation in the prior art for the application of Smith to Ogle or Link. The Examiner makes reference only to how "it would have been obvious to one of ordinary skill in the art" to add the upper arm of Smith to the frame of either Ogle or Link. This is not the required showing but an exercise in the hindsight frowned upon by the courts.

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An explanation why a skilled artisan would have been motivated to make the claimed combination should be set forth by an examiner after every rejection under 35 U.S.C. §103. MPEP §706.02(j). The lack of any such explanation, along with the other reasons discussed above, verifies that a prima facie case of obviousness has not been made to justify the rejection of claims 5.

Claim 6 has the additional limitation that the cross-section of the upper arm has an area that progressively decreases from the frame-vertex to the arm's distal-end. Although the Examiner states that this feature is also disclosed in Smith, no structure on the Smith lure is identified by the Examiner as serving as the frame-vertex. If track 12 arguably discloses an upper arm with an oblong cross-section, then the front towbar 11 is the only structure shown in Smith from where it can be said the track's cross-section begins to decrease in area. The midpoint of the towbar cannot be regarded as disclosing the frame-vertex in the application because the cross-section of the sections extending in both directions from this point has an area that remains constant until connecting with the track. Absent disclosure of a frame-vertex having the features claimed by the application, a prima facie case of obviousness has not been made to justify the rejection of claims 6 or any of the claims that are dependent to it.

Furthermore, the additional limitation of claim 7, wherein the cross-section of the upper arm has its greater dimension in the plane of the frame, is also not disclosed by Smith. If track 12 is arguably disclosing the upper arm of Applicant's invention, then the drawings in Smith show only a structure having a cross-section with its longest dimension being in a direction orthogonal to the plane of the lure. Moreover, substantial modification of the track in Smith is necessary for the structure to have an upper surface that is wider than its side edge so as to arrive at the claimed device. Such modification would, however, be inconsistent with the configuration of the track that is needed so that each of its ends can attach to the opposite ends of the towbar. If a proposed combination change the principle of operation of the prior art being modified, the teachings of the references are then not sufficient to render the claims prima facie obvious. MPEP §2143.01.

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For all of these reasons, Applicant respectfully asks that the rejection of claims 5, 6 and 7 be withdrawn and that all three, in addition to claims 8-13 that are dependent from them, be allowed.

Rejection of Claims 14 and 15 under 35 U.S.C. §103(a)

Claims 14 and 15 were specifically rejected under 35 U.S.C. §103(a) as unpatentable over Ogle or Link in view of Link. Neither Ogle or Link disclose the added limitation that the frame in claim 2 be formed from transparent polymeric material. Neither do these references disclose such a frame being formed from transparent polymeric material having color. Link only discloses that a rattle chamber 52 attached to the elastomer assembly can be transparent. Neither reference describes any structure being made from a polymeric material that is both transparent and having color.

There is no teaching in Link that would suggest modifying the elastomer device by making the device from the transparent material in question rather than an elastomer. The rattle chambers are shown in the drawings to be small structures designed to simply hold a number of smaller rattle members 54. Given their size, there is no basis in the reference to suggest that material used under little stress for a rattle chamber could be formed into the collar and filaments of the Link device and still insure that the principle of operation intended for the device would remain the same. The same point is applicable to any modification of the Ogle lure with this material.

There is no showing by the Examiner in this Office Action of any motivation in Link or Ogle to modify and then combine them for arriving at Applicant's novel invention. The Examiner once again states as to how "it would have been obvious to one of ordinary skill in the art" to take the transparent material in Link and add it the devices in both Link and Ogle. As stated above, the Examiner must set forth an explanation as to why a skilled artisan would have been motivated to make the claimed combination. His statement in the Office Action falls short of this required showing and leaves the impression that the modification and combination in question can only be arrived at through hindsight following disclosure by Applicant of his improved lure.

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On the basis of the above remarks, Applicant respectfully ask that the rejections of claims 14 and 15, in addition to claims 16-20 that are dependent to them, be withdrawn and that each claim be allowed.

Rejection of Claims 2, 7, 15 and 27 under 35 U.S.C. §112 ¶2

Claim 2 was rejected as being indefinite for failing to be clear as to what "non-destructive force" quantifies. Claim 2, as amended, no longer includes the term in question. Claim 1 has been amended to include the limitation that "the frame always retains the original configuration absent force-induced flexing sufficient to break the frame."

Claim 7 has been amended to overcome the rejection under 35 U.S.C. §112 ¶2 that there was insufficient antecedent basis for the limitation "the greater dimension." Claim 7 now specifies that the cross-section of the upper arm has two dimensions, the greater dimension being in the plane of the frame.

Claim 15 had been rejected as indefinite for claiming polymeric material that is both transparent and has color. This rejection was discussed during the interview on May 4, 2004, and Applicant thanks the Examiner for the indication that it would be withdrawn.

Claim 27 was rejected for the lack of a sufficient antecedent for the limitation "hook." Claim 27 has been amended to include the proper antecedent.

New Claims

Claim 34 is a new independent claim directed to a spinnerbait lure having a frame with upper and lower arms extending divergently from a frame-vertex where the frame is in a predetermined shape when in a non-stressed condition. The shape is one where the arms are in a substantially fixed configuration with one another. The frame also has at least one blade secured to it and a metal body embedded within it. Moreover, the frame is formed from an integral length of polymeric material where the polymeric material is selected such that the frame always retains its original configuration absent force-induced flexing that is sufficient to break the frame.

Claim 34 is not anticipated or made obvious by any of the references cited by the Examiner in the Office Action. None of these references disclose a spinnerbait lure having a metal body embedded within the frame of the lure. There is also no disclosure in the prior art cited of a

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frame formed from an integral length of polymeric material having a predetermined shape in a non-stressed condition, the shape having the frame's upper and lower arms in a substantially fixed configuration with one another, where the polymeric material is selected so that the frame always retains its original configuration short of force-induced flexing sufficient to break the frame.

Claim 34 is in condition for allowance.

Claims 27-32 depend from claim 34 and are likewise allowable claims. Furthermore, these claims, as amended or made dependent to amended claims, overcome the rejection of being unpatentable under 35 U.S.C. §103(a) by adding the limitation that the lure further includes a jig embedded within the frame, where the embedded metal body is the jig-head. Applicant respectfully requests that the rejection of claims 27-32 in the Office Action be withdrawn.

Claims 35-38 are new claims that are dependent to claim 34. Claim 35 specifies that the lure's frame be dimensioned to exhibit flexing resilience during fishing. Claim 36 adds the further limitation that the frame's upper arm have an oblong cross-section. Claim 37 further requires that the cross-section have an area that progressively decreases going from the frame-vertex along the upper arm to its distal-end. Claim 38 is dependent to claim 37 and adds that the cross-section has two dimensions where the greater one is in the plane of the frame.

Claim 39 is also a new independent claim. It is directed to a spinnerbait lure having an integral, polymeric frame and at least one blade secured to the frame. The frame includes upper and lower arms extending divergently from a frame-vertex with the arms meeting only at the frame-vertex. The frame for the lure has a predetermined shape when in a non-stressed condition, the shape finding the arms in a substantially fixed configuration with respect to one another. In addition, the frame always retains its original configuration absent force-induced flexing that would be sufficient to break the frame.

Claim 39 is not anticipated or made obvious by any of the references cited by the Examiner in the Office Action. None of these references disclose a spinnerbait lure having a integral, polymeric frame with upper and lower arms meeting only at a frame-vertex, where the frame has a predetermined shape in a non-stressed condition, the shape having the frame's upper and lower arms in a substantially fixed configuration with one another, and the frame always

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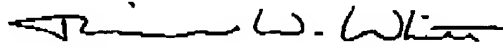
retains its original configuration absent force-induced flexing sufficient to break the frame. Claim 39 is in condition for allowance.

Claims 40-45 depend from claim 39 and are likewise allowable claims. Claim 40 specifies that the lure include an upper arm having an oblong cross-section. Claim 41 adds the limitation that this cross-section's area progressively decrease going from the frame-vertex to the upper arm's distal-end and the cross-section's greater dimension is in the plane of the frame. Claim 42 has the lure further include a jig having a jig-head and hook, where the jig-head is embedded in the lower distal-end of the frame. Claim 43 adds the limitation that the lower arm of the frame is substantially tapered adjacent to the proximal-end of the jig. Claim 44 requires that the frame be transparent and claim 45 adds the limitation that the frame also have color.

Conclusion

Applicant's invention, as set forth in the pending claims, represents a highly novel spinnerbait lure. Applicant believes that claims 1-20 and 27-45 include several structural features not disclosed or suggested in the prior art. Applicant submits that all rejections to claims 1-20 and 27-33 in the Office Action have been traversed by amendment and argument, placing the application in condition for allowance. Applicant respectfully asks that these rejections be reconsidered and withdrawn by the Examiner. Early favorable action is earnestly solicited. The Examiner is invited to call the undersigned if such would be helpful in resolving any issue which might remain.

Respectfully submitted,



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